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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/767,669

01/29/2004

Heinrich Lang

LMX-129 CON

5424

7590

09/23/2004

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EXAMINER

SHAFFER, RICKY D

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,669

Applicant(s)

LANG ET AL

Examiner

Ricky D. Shafer

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/800,114.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The substitute specification and drawings filed on May 17, 2004 have been entered.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lang et al ('577).

Lang et al discloses a rearview mirror assembly for a vehicle comprising a mirror element having a mirror pane (110) affixed to a carrier plate (142); a positioning apparatus (114) affixed to the carrier plate opposite the mirror pane; a framing (106), the positioning apparatus secured to the framing, a bracket (107) having an upper strip and a lower strip, the bracket releasably clamped to the framing; and first and second holding arms (101), the first (upper) holding arm being clampingly disposed between the upper strip and the framing and the second (lower) holding arm being clampingly disposed between the lower strip and the framing, wherein the upper strip defines a first recess to receive the retaining pin (108) of the first holding arm and the lower strip defines a second recess to receive the retaining pin (109) of the second holding arm. Note figures 10 to 12 along with the associated description thereof.

4. Claims 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Boddy ('385).

Boddy discloses a rearview mirror assembly for a vehicle comprising a mirror element having a mirror pane (12) affixed to a carrier plate (84); a positioning apparatus (92) affixed to the carrier plate opposite the mirror pane; a framing (14), the positioning apparatus secured to the

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framing, a bracket (32) having an upper strip and a lower strip, the bracket releasably clamped to the framing; and first and second holding arms (18), the first (upper) holding arm being clampingly disposed between the upper strip and the framing and the second (lower) holding arm being clampingly disposed between the lower strip and the framing, wherein the upper strip defines a first recess to receive the first holding arm and the lower strip defines a second recess to receive the second holding arm, wherein said first and second recesses each have at least one projection (48) which extends through at least one complementary recess (50) of the first and second holding arms, respectively, to be rotationally secured the position of the mirror assembly. Note figures 3 and 4 along with the associated description thereof.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al ('703) in view of Schultz ('005).

Lang et al discloses a rearview mirror assembly for a vehicle comprising a mirror element having a mirror pane (7) affixed to a carrier plate (24); a positioning apparatus (2) affixed to the carrier plate opposite the mirror pane; a framing (48), the positioning apparatus secured to the framing, a bracket (47) having upper and lower strips (44') having recesses, the bracket releasably clamped to the framing; a holding arm (46) being clampingly disposed between the upper and lower strips and the framing and a housing cover (50), note figures 7 and 8 along with

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the associated description thereof, except for explicitly stating that the holding arm consists of two arms.

Schultz teaches is well known to use a plurality of arms in the same field of endeavor for the purpose of attaching a mirror assembly to a vehicle.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the holding arm of Lang et al to include a plurality of individual arms as taught by Schultz in order to selectively replace damage/defective arm component(s) so as to reduce manufacturing costs or after market costs to an individual.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al ('703) in view of Schultz ('005) as applied to claims 11 and 12 above, and further in view of Bos et al ('996) and Perry ('814).

Lang et al in view of Schultz discloses all of the subject matter claimed, note the above explanation, except for explicitly stating that the framing and cover are made of a particular plastic material.

Bos et al teaches it well known to use an ABS plastic material in the same field of endeavor for the purpose obtaining a housing cover.

Perry teaches it well known to use a fiberglass reinforced plastic material in the same field of endeavor for obtaining a framing (bracket).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the housing cover of Lang et al to an ABS plastic material as taught by Bos et al in order to provide a durable, light weight mirror cover and similarly modify

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the framing of Lang et al to include a fiberglass reinforced plastic material as taught by Perry in order to provide a durable, light weight framing element with dampening characteristics.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 10 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/800,114. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application discloses no additional invention or discovery other than what was already claimed and allowed in application (09/800,114) or what would have been obvious to one of ordinary skill in the art at the time the invention was made.

Copending Application No. 09/800,114 discloses a rearview mirror assembly for attachment to a vehicle via a holding tube, the assembly comprising a housing (5) including a framing element (4) configured to attach to the holding tube (10); and a clamping part (12) configured to attach to the holding tube disposed opposite of the framing element, the framing element and the clamping part cooperating to clamp about the holding tube and releasably attach to each other, the clamping part further configured to fastenably hold a mirror element (6), wherein the clamping part has a hook element (16) and the framing element has a snap connection, the hook element and the snap connection snap-connectable to secure the framing element and the clamping part together; wherein the framing element defines a first recess and the clamping part defines a second recess, the first and second recess configured to encase the holding tube. Note Fig. 2

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference numeral (38b), disclosed on page 8 of the specification, has not been illustrated. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being

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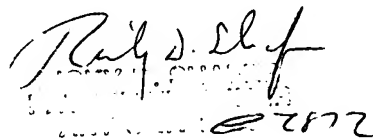
amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDS

September 19, 2004

Handwritten signature of Ricky D. Shafer, with the number 2872 written below it.